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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.  |
|--|-------------|----------------------|---------------------|-------------------|
| 10/697,083   | 10/31/2003  | Wesley Scott Ashton  | ASHTON0009          | 9725              |
| 7590   | 06/14/2006  |                      | EXAMINER            |                   |
| Wesley Scott Ashton<br>8549 Black Foot Court<br>Lorton, VA 22079 |             |                      |                     | RODRIGUEZ, RUTH C |
|  |             |                      | ART UNIT            | PAPER NUMBER      |
|  |             |                      | 3677                |                   |

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                      |
|------------------------------|------------------------|----------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>  |
|                              | 10/697,083             | ASHTON, WESLEY SCOTT |
|                              | <b>Examiner</b>        | <b>Art Unit</b>      |
|                              | Ruth C. Rodriguez      | 3677                 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 31 May 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 21-31,36 and 37 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-31,36 and 37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 21, 31 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Denny et al. (US 6,047,209).

A method of dispensing a substance into a mouth wherein the substance is selected from a group consisting of a breath freshener, a medication and a flavoring agent (Abstract). The method comprises the steps of: (a) providing a mouth and tongue stud (103,201) including a means for dispensing a substance formed in a portion of the stud (Abstract). The means of dispensing a substance contains the substance (Abstract); (b) mounting the stud in a fistula of a wearer's tongue or in the wearer's lip (Fig. 3); and (c) dispensing the substance into the wearer's mouth (fig. 3). The stud

comprises a bar (404) having ends (Figs. 4 and 5). A first end member (406,501) is attached to one end of the bar and a second end member (402) attached to an other end of the bar. The first end member is removably attached to the one end of the bar (Figs. 4 and 5).

Regarding claim 31 having similar limitations to claim 21, the rejection of claim 21 serves to reject claim 31 since it has similar limitations and Denny discloses that the substance is a medication (C. 3, L. 29-45).

A method of dispensing a substance into a mouth wherein the substance is a medication. The method comprises the steps of: (a) providing a mouth and tongue stud including a means for dispensing a substance formed in a portion of the stud (Abstract). The means of dispensing a substance contains the medication (Abstract); (b) mounting the stud in a fistula of a wearer's tongue or in the wearer's lip (Fig. 3); and (c) dispensing the substance into the wearer's mouth (fig. 3). The stud comprises a bar (404) having ends, a first end member (406,501) is attached to one end of the bar and a second end member (402) is attached to an other end of the bar (Figs. 1-5). The bar is a straight bar (404) made of metal and the first end member (406,501) removably attaches to one end of the bar (C. 4, L . 43-46).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22-30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denny.

Denny discloses a method for dispensing a medication in accordance with the steps mentioned above for the rejection of claims 21, 28, 31 and 37. Denny discloses the use of salve, hydrogen peroxide, polysporin and other antibiotic or cleansing fluid as the medication. Denny fails to disclose that the substance comprises a breath freshener or a flavoring agent or a breath freshener mixed with a flavoring agent or a medication mixed with a breath freshener or a medicine with a flavoring agent. However, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance can comprises a breath freshener or a flavoring agent or a breath freshener mixed with a flavoring agent or a medication mixed with a breath freshener or a medicine with a flavoring agent since the medication will have a flavor to it whether the flavor pleasantly appeals to user or not it is still has a flavor to it and as for the breath freshener, the antibiotic medication will kill also the bacteria that causes bad breath and therefore work as a breath freshener.

The substance is disposed into the wearer's mouth by injecting the substance into the piercing. Although Denny fails to disclose that the substance is disposed by dissolving the substance over time in the wearer's saliva, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have the substance after being injected into the piercing also being dissolved over time in the

wearer's saliva since the substance will not be dissolved immediately by the wearer's saliva in the mouth but rather it will take an amount of time for the substance to be completely dissolved.

### ***Response to Arguments***

6. Applicant's arguments filed 31 May 2006 have been fully considered but they are not persuasive.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., structure that would allow them to remain in the tongue or other piercing that involves the mouth) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. The Applicant argues that Denny fails to disclose that the device can be applied to "intraoral piercings" because Denny discloses the use of hydrogen peroxide, soap and water and topical antibiotics "which would not include piercings involving the mouth". The Examiner fails to be persuaded by this argument. Denny discloses that the device is used in "orifices of pierced human body parts" in the field of the invention and the mouth is a human body part. Regarding to the use of hydrogen peroxide, soap and water and topical antibiotics, as a factor to indicate that the device is not applied to intraoral piercings, Denny discloses the use of these substances as examples of what

can be used in combination with this device and does not discloses that all of these substances need to be used, therefore, these substances do not teach away from using the device in the mouth since the use of oral compositions having hydrogen peroxide, saline solutions and topical antibiotics is known in the art of treating lesions or infections in the mouth.

9. The Applicant argues that Denny fails to disclose a stud comprising a bar with ends where a first end member is removably attached to the bar and a second end member is attached to the other end. The Examiner fails to be persuaded by this argument. When the embodiment of Figures 4 and 5 is considered as the stud with the bar being member 404 and the first member being member 406 or 501 the limitations of the claims are met even when claims recite that the bar is a straight bar.

10. Regarding claims 28-30, the argument presented by the Applicant is that Denny fails to disclose that "the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva". This argument fails to persuade. The claim does not specify what amount of time is considered "over time". Therefore, the term "over time" can be considered, as explained by the Examiner in the revised rejection for claims 28-30, the time it takes for the substance to be completely dissolved into the wearer's mouth by the saliva that can take several minutes. The claim will remain rejected until the claim provides more specific details for the term "over time".

11. The Applicant argues that Denny fails to disclose that the medication has a breath freshener or a flavoring agent. Upon detailed study of the application, the Examiner found that the specification do not provide any specific information about the

substances being considered as flavoring agents or breath freshener. Therefore, the Examiner decided to modify the rejection of the claims directed to the flavoring agent and the breath freshener to indicate that although Denny fails to disclose that the medicine being used with the device have these substances it is obvious that the medicine will have a flavor to it and therefore comprises a flavoring agent that provides the particular flavor that the medicine has regardless of whether this flavor is appealing to the user or not. As for the breath freshener, the medicine especially the topical antibiotic will not only kill the bacteria in the piercing but it will also dissolve in the saliva of the user and it will also kill the bacteria causing the bad breath of an user and therefore it works as a breath freshener.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Warren, Jr. (US 3,754,332), Lariccia et al. (US 3,943,928), Cournut et al. (US 4,020,558), Harris et al. (US 4,551,329), Garay et al. (US 4,861,268), Stanley et al. (US 5,855,908), Denny et al. (US 6,047,209), Katz (US 6,326,022 B1) and Levy et al. (US 6,592,860) are cited to show state of the art with respect to devices used to deliver a medication or other substance into a wearer's mouth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45. If attempts to

Art Unit: 3677

reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

rcr  
June 9, 2006

  
ROBERT J. SANDY  
PRIMARY EXAMINER